

### **REMARKS**

Claims 40-53, 84-97, 99-101, 111-118, and 128-136 are pending in the application and stand finally rejected. With this amendment, Claims 42, 44, 86, 88, 111-118 and 128-136 are cancelled. Upon entry of the amendments, Claims 40-41, 43, 45-53, 84-85, 87, 89-97, and 99-101 remain pending in the application.

Claims are cancelled to simplify issues on appeal, and are not otherwise amended. The specification has been amended to comply with 37 CFR 1.177(a). Applicants respectfully request entry of the amendments.

### **CONSIDERATION AFTER A FINAL REJECTION**

Entry of the amendments cancelling claims is proper after a Final Rejection because the amendments place the claims in a state of allowability or at least in better condition for appeal. Upon entry of the amendments, independent Claims 40 and 84 remain pending.

With this Amendment, Applicants offer a Supplemental Oath/Declaration and address a double patenting rejection, which also place the claims in better condition for appeal. Finally, cancelling claims has mooted a rejection under §112. Applicants respectfully request acceptance and entry of these amendments as discussed below.

### **OBJECTION TO THE APPLICATION UNDER 37 C.F.R. § 1.172(A)**

It appears from remarks on page 2 the Final Rejection that this objection has been withdrawn, as "proper assents of the Assignee" were filed by Applicants in November 2007. Applicants believe that no further action is required to comply with this requirement.

### **OATH/DECLARATION**

After final, Applicants submit a Declaration correcting the errors pointed out at page 2 of the Final Rejection. The enclosed declaration

- a) identifies the foreign application on which priority is claimed pursuant to 37 CFR 1.55 by specifying the application number, country, day, month, and year of its filing.
- b) identifies at least one error relied upon to support the Reissue Application; and
- c) contains a statement that every error corrected in the present application and not covered by a prior oath/declaration arose without any deceptive intention on the part of the applicant.

Applicants respectfully request acceptance of the Declaration after a Final Rejection because it puts the claims in better condition for appeal.

### **REJECTION UNDER 35 U.S.C. § 112**

Claims 42, 44, 86, 88, 113, 115, 130, and 132 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. This rejection is mooted by cancelling the claims. Applicants respectfully request the rejection be withdrawn.

### **DOUBLE PATENTING**

In response to the double patenting rejection, Applicants enclose with this reply a Terminal Disclaimer in favor of U.S. Application Serial No. 10/643,673. Applicants respectfully request the Terminal Disclaimer be accepted and entered after a final rejection to simplify matters on appeal.

**REJECTION UNDER 35 U.S.C. § 251**

As applied to the amended claims, pending Claims 40-41, 43, 45-53, 84-85, 87, 89-97, and 99-101 stand rejected as being an improper recapture of subject matter allegedly given up during original prosecution. Applicants respectfully maintain their position that the claims avoid the recapture rule for the reasons discussed in their November 20, 2007 amendment.

First, broadening aspects in the claims are not related to subject matter given up during prosecution because the current claims are independent and distinct from the claims in the parent patent U.S. Patent 6,168,626. The current claims were offered along with the issued claims of the '626 patent in Reissue Application No. 10/141,374 filed August 23, 2002. The current claims were restricted by the Examiner because they were considered independent and distinct from the parent claims. As amended, a further distinction is shown in the fact that the current claims do not recite a step of cooling while keeping the deformed state, while all of the issued claims of the '626 patent contain that limitation. Restriction is proper and the claims are independent and distinct.

Accordingly, comments and amendment made by Applicants in pursuing the claims that resulted in the allowed claims of the '626 patent are irrelevant to the recapture analysis of the claims in the current reissue application. Applicants respectfully request the recapture rejection be withdrawn.

Applicants also maintain their position that, even if broadening aspects of the claims are considered to be related to surrendered subject matter, the claims are nevertheless narrowed in other ways to avoid the recapture issue. As discussed in the November 20, 2007 amendment, the current claims all recite that the temperature to which a crosslinked UHMWPE is heated is below the melting point. Had such a limitation been present or offered by amendment during

prosecution of the original claims, those amended claims would have further distinguished over the cited art.

For all these reasons, Applicants respectfully request the recapture rejections be withdrawn.

#### **REJECTION UNDER 35 U.S.C. §§ 102/103**

##### ***Rejection over Kitamaru alone (anticipation)***

As a preliminary matter, the rejection of Claims 42, 44, 86, 88, 113, 115, 130, and 132 as anticipated by *Kitamaru* (U.S. Pat. No. 3,886,056) is mooted by canceling the claims. Further, Claims 99 and 135 have been cancelled, mooted the obviousness rejection. Applicants respectfully request these rejections be withdrawn.

##### ***Rejection over Zachariades in view of Kitamaru***

Claims 40-53, 85-97, 100-101, 111-118, 128-134, and 136 are rejected as obvious over the *Zachariades* reference (U.S. Pat. No. 5,030,402) in view of the *Kitamaru* reference (U.S. Pat. No. 3,886,056). Applicants respectfully traverse the rejection as applied to the amended claims and request reconsideration.

As discussed in the November 20, 2007 Amendment, it is not clear why the person of skill in the art would combine the references by adding some aspects of *Zachariades* to *Kitamaru* (such as the heat treatment below the melting point), but not others (direct molding to a final implant, use of a non-crosslinked UHMWPE.) Applicants note that in the Final Rejection, the references are applied in the opposite way, with *Zachariades* primary and *Kitamaru* as secondary. Applicants believe this does not change the analysis. Regardless of how the references are combined, one of ordinary skill in the art has to pick and choose which of the features of one to add to the other. This amounts to impermissible hindsight based on

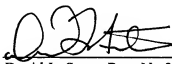
Applicants' disclosure of their own invention. Applicants respectfully request the art rejections be withdrawn.

#### CONCLUSION

Applicants believe that the pending claims are in an allowable condition and respectfully request a Notice of Allowance. In the alternative, Applicants submit the amendments place the claim in better condition for appeal and respectfully request their entry before proceeding to an appeal. The Examiner is invited to telephone the undersigned if that would be helpful to resolving any issues.

Respectfully submitted,

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